

## **REMARKS**

Claims 38-63 stand rejected. Claim 43 was cancelled. Claims 38, 44-46, and 50 have all been amended to correct various informalities and typographical errors. Claim 38 was amended to so that a claim term has the same form as its antecedent. Claim 50 was amended to depend from claim 49 rather than claim 47. Claims 38-42, and 44-63 are presently pending. The amendments to the specification and the claims do not add new matter and are supported by the originally filed specification. In view of the foregoing amendments and the following remarks, Applicant respectfully submits that all of the presently pending claims are allowable. Reconsideration of the Application is respectfully requested.

### **1. Rejection of Claims 59 and 60 (35 U.S.C. § 112)**

Claims 59 and 60 were rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. Applicant respectfully traverses the rejection for at least the following reasons.

Claim 59 recites “wherein the game ticket is a future draw lottery ticket having indicia which are matched against a future drawing event to determine if the lottery ticket is a winner of the separate ticket-based lottery game.” Applicant specifically described such a future draw lottery ticket in the originally filed specification. For example, on page 55 and Figure 30 of the original specification:

*The ticket 580 bears the legend near the bottom “POWERBALL DRAWING 03-17-00”. This refers to a subsequent drawing to be held in which the bar code and human readable numbers 594 and 586 will be used in a drawing to determine an additional prize. This serves as an additional incentive to purchase the tickets.*

The ticket shown in Figure 30 includes numbers for matching in a conventional “powerball type drawing”, as well as an indication of when such drawing will occur - i.e. a time subsequent to the purchase of the ticket. The described game is “in addition” to the instant matching game which is also shown in Fig. 31 and described in the specification. Accordingly, Applicant submits that the language which the Examiner has questioned in claim 59 is properly supported in the original specification. Withdrawal of the § 112 rejection of claim 59 is respectfully requested.

Claim 60 recites “wherein whether the game ticket wins the jackpot game is determined randomly at the time the game ticket is dispensed.” In at least one version of an example embodiment, described at the top of page 55 of the specification and shown in

Figures 28 to 31, whether the jackpot is won is determined by “matching the numbers on the ticket 580 as well as the number 596 or 598 with the right color”. Although this does not by itself indicate that the jackpot winner is determined randomly at the time of purchase, related discussion of the same embodiment indicates that the numbers which are used to determine the jackpot winner may themselves be randomly selected at the time of ticket dispensing, thus providing support for the claim limitation questioned by the Examiner. In particular, the specification at page 55, paragraph 4 describes an embodiment where “[t]he numbers printed on the ticket 580 can be determined by a random number generator” and that “[t]his embodiment of the invention has the advantage that the ticket 532 is incomplete and thus is of little or no value until the further play information is printed, either on the ticket 522 in blank spaces, or on the separate ticket 580.” Therefore, “wherein whether the game ticket wins the jackpot game is determined randomly at the time the game ticket is dispensed” is supported in the specification.

For at least the above reasons, the Applicant requests withdrawal of the § 112 rejection of claim 60.

## **2. Rejection of Claim 50 (35 U.S.C. § 112, Second Paragraph)**

Claim 50 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claim 50 has been amended to depend from claim 49. Thus, the Applicant respectfully submits that the rejection is obviated.

For at least the above reasons, the Applicant requests withdrawal of this rejection.

## **3. Rejection of Claims 38-63 (35 U.S.C. § 103(a))**

Claims 38-63 stand rejected under 35 U.S.C. § 103(a), the Examiner alleging that these claims are unpatentable over U.S. Patent No. 5,944,606 to Gerow (“Gerow”) in view of U.S. Patent No. 5,112,050 to Koza et al. (“Koza”) in further view of U.S. Patent Re. 35,864 to Weingardt (“Weingardt”). The Applicant respectfully traverses this assertion and submit that the rejections should be withdrawn for at least the following reasons.

Applicant’s claim 38 is generally directed to a multi-jurisdiction jackpot game which is played by participants in various scratch-off instant ticket games. Claim 38 recites, in relevant part:

a multi-jurisdiction jackpot game offered across a plurality of jurisdictions;

a plurality of scratch-off instant ticket games each available in at least one of the plurality of jurisdictions;

a plurality of scratch-off instant game tickets, each ticket being associated with at least one of the instant ticket games in at least one of the plurality of jurisdictions, each ticket having indicia for use in the play of the scratch-off instant ticket game, and each ticket having a respective machine readable ticket code unique to that ticket in said system, the machine readable ticket code for use in the play of the multi-jurisdiction jackpot game;

Gerow generally describes a pull-tab game with a jackpot. Although Gerow also describes a variant of his system with multiple machines, these machines share a single pull-tab game with a single cardset – i.e. a single game, rather than a plurality of such games. *See, e.g.,* Gerow at 7:33-42. Thus, Gerow neither teaches nor suggest combining a plurality of games in a plurality of jurisdictions with a multi-jurisdiction jackpot game offered across the plurality of jurisdictions. To correct this deficiency, the Examiner proposes a combination of Gerow with Weingardt, which generally describes using a pari-mutual jackpot game with various casino games. Applicant submits that this proposed modification of Gerow is an improper hindsight reconstruction which uses Applicant’s claimed invention as a map to improperly pick and choose elements from the cited art.

The Examiner’s alleged motivation to make the proposed combination is that “Gerow discloses that many state lotteries fall into the progressive category because the prize increases over time as more players participate”. However, Gerow’s observation about state lotteries having progressive properties applies to “state numbers lotteries”. *See* Gerow at 1:50. These “numbers games” are future draw lottery games like Powerball, Lotto, and similar games. Gerow does *not* make this observation with respect to “instant ticket lotteries” such as the recited scratch-off instant ticket games of Applicant’s claim 38. In fact, Applicant submits it is well-known that conventional state *instant* ticket lottery games do *not* have any such property.

The Examiner also discusses the sharing of “auditing data” as being a possible motivation for combining the cited references. While disagreeing with the Examiner’s conclusions regarding the sharing of “auditing data”, the Applicant also does not understand how the discussion of shared audit data would lead an ordinary artisan to make a shared prize progressive game with a single jackpot shared across multiple jurisdictions – if anything this seems to be the horse following the cart – the need for shared audit data would arise only once one had created a multiple jurisdiction game according to Applicant’s claimed invention. Accordingly, Applicant respectfully submits that the use of shared audit data

would not lead an ordinary artisan to combine or modify Gerow to obtain a the system recited in Applicant's claim 38.

Claims 39-42 and 44-48 ultimately depend from claim 38 and therefore include all of the features recited in claim 38. As more fully set forth above, the cited references do not render unpatentable claim 38. As such, it is respectfully submitted that claims 39-42 and 44-48 are patentable over the cited references for at least similar reasons as claim 38.

Claim 49 recites multiple independent instant ticket lottery games. For at least reasons similar to those discussed above for claim 38, this is neither taught nor suggested by the cited references. Claim 50 depends from claim 49 and thus should be allowable for at least similar reasons. Claim 63 should be allowable for similar reasons.

Amended Claim 51 is generally directed to several features that tie the operation of the jackpot game to the dispensing of tickets in multiple ticket-based lottery games. As discussed above for claim 38, Gerow teaches a jackpot with a *single* pull-tab game. Neither Gerow, nor Gerow in combination with the other references teach the the combination of a jackpot game with multiple instant ticket games. Separately and independently, neither Gerow nor the proposed combination teach or suggest "starting to accumulate a new prize pool **upon the detection of the dispensing** of an additional ticket after the detection of said winner". In particular, the system of Gerow has appears to have a single jackpot prize for each book or deck of tickets.

Claims 52-56 depend from claim 51, and therefore should be similarly allowable. Similarly claims 57 and 58 has multiple instant ticket games combined with the jackpot game and should be allowable for similar reasons.

Claim 59 recites that the game ticket is a future draw lottery ticket. Gerow does *not* teach or suggest such a ticket, and the Examiner has not explained how Gerow would allegedly be modified to product the system claimed in Applicant's claim 59.

Claim 60 recites that whether the game ticket wins the jackpot game is determined randomly at the time the game ticket is dispensed. This feature is neither taught nor suggested by the cited references. In particular, Gerow describes only a pre-printed jackpot

card to determine which ticket is the jackpot winner and does not determine whether a card is a jackpot winner at the time it is dispensed.

For at least the above reasons, the Applicant requests withdrawal of this rejection.

**VI. Conclusion**

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Entry of the amendment, and prompt reconsideration and allowance of the present application are therefore earnestly solicited. The Examiner is invited to telephone Applicant's undersigned representative if any question arises concerning the present application.

Respectfully submitted,

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